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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,768	02/07/2002	Edmund Ming Kwan	PA2354US	1636

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EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,768

Applicant(s)

KWAN, EDMUND MING

Examiner

Igor Borissov

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 56-57 and 86-87 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 56-57 and 86-87. The following new matter was introduced into the claims: "a client can freely remove rights of usage of a hosted enterprise solution of a subscriber or non-subscriber in its collaboration community".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38-91 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

Independent Claims.

Claims 38, 59 and 90. The second sub-step discloses modifying partner's subscription fee, while the step of establishing or defining a subscription fee is omitted.

Also, **claims 38, 59 and 90** are rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "if any" implies the absence of any subscription fee, while the second sub-step defines at least one subscription fee.

Also, **claims 38, 59 and 90** are confusing, because the term "can" implies the potential capability, not an actual method step.

Dependent Claims.

Claims 39-58, 60-89 and 91 are rejected as being dependent claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 38-58 and 90-91 are rejected under 35 U.S.C. 101 because the claimed method for cost-sharing of a host subscription fee does not recite a limitation in the technological arts. The independently claimed steps of: *"generating by a client a list of partners; generating a value by applying a predetermined function to a partner's subscription fee; modifying client's host subscription fee based upon results of said generated value; and utilizing a network for communicating a balance of said client's host subscription fee to the client"*, are the abstract ideas which can be performed mentally without interaction of a physical structure. The method step: *"utilizing a network for communicating a balance of said client's host subscription fee to the client"* may be understood as merely notifying the client about changes in his account via the phone or other participants. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)).

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shorter (US 2002/0198782).

Shorter teaches a method and system for long-term customer retention by applying an incentive on a monthly, on-going basis, comprising:

Independent Claims.

Claims 38, 59 and 90. Generating by a user (client) a list of referred subscribers (partners) [0054]; generating a value by applying a predetermined function to a referred subscribers subscription fee [0035] - [0038]; [0045]; modifying client's host subscription fee based upon results of said generated value [0035] - [0038]; and utilizing a network for communicating a balance of said client's host subscription fee to the user [0030]; [0047].

Information as to *is a user a client or not, and is a referred subscriber a partner or not*, is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Shorter would be performed the same regardless is the user a client or not, and is the referred subscriber a partner or not.

Dependent Claims.

Claims 39 and 60. Said method and system, wherein said subscription is offered to a client as an option [0030].

Claims 40-41, 44-45, 62-63 and 64-65. Said method and system, wherein the user selects candidates to become subscribers among friends and family members [0034]. Information as to *flexibility to decide*, is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claims 42-43 and 69-70. Said method and system, wherein subscribers have different subscription plans [0045].

Claim 46. See claim 38.

Claims 47 and 61. See claim 38.

Claims 48 and 78. See claim 38.

Claims 49 and 88. Said method and system, wherein each subscriber can correct the subscription data [0054].

Claims 50-51, 75 and 80. See claim 38.

Claims 52 and 76. Said method and system, wherein there is at least one user that is a non-subscriber [0030].

Claims 53 and 77. See claim 38.

Claims 54-55 and 71. See claim 38.

Claims 58 and 89. See claim 38.

Claim 66. See claim 38.

Claim 67. See claim 38.

Claim 66. Said method and system, wherein the system is configured to receive a subscriber's credit card information [0047].

Claims 72-73. Said method and system, wherein the system is configured to offer a number of service plans to users generate invitations to all invitees [0044].

Claims 74-75 and 79. Said method and system, wherein the system is configured to update a user's host subscription fee [0047].

Claims 81 and 84. See claim 72.

Claim 82. See claim 38.

Claim 83. Information as to *a hosted enterprise solution is a document workflow enterprise collaboration software solution* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 85. See claim 38.

Claim 91. Said method and system, wherein the reward program is offered to the user as an option [0030].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

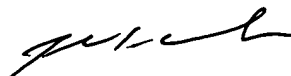
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

IB



JOHN G. WEISS
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